
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2008-1151
(Serial No. 09/326,405)

IN RE DAVE B. LUNDAHL

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

APPELLANT'S BRIEF AND ADDENDUM

Party for Whom the Brief is Filed:
Dave B. Lundahl

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March 6, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Dave B. Lundahl v. United States Patent and Trademark Office
No. 2008-1151

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)
Dave B. Lundahl certifies the following (use "None" if applicable; use extra sheets if necessary):

1. The full name of every party or amicus represented by me is:

Dave B. Lundahl

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

Dave B. Lundahl, Ann Lundahl, Travis Lundahl, Nicole Clark and Inovadeas, LLLP, a Colorado limited liability limited partnership

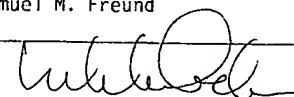
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None

4. There is no such corporation as listed in paragraph 3.

5. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

William W. Cochran, James R. Young, Samuel M. Freund
Cochran Freund & Young LLC



February 5, 2008

Date

Signature of counsel

William W. Cochran
Printed name of counsel

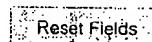
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I. Statement of Related Cases

There are no related cases pending before this or any other tribunal.

II. Jurisdictional Statement

This appeal is from the Decision on Appeal of the United States Patent and Trademark Office dated October 27, 2006, pages A13-21 of the Joint Appendix, and the Decision on Request for Rehearing, pages A1-3.

The United States Patent Office has original jurisdiction of the patent application under 35 USC §2. The Decision on Rehearing was a “final decision” of the Agency. Jurisdiction by the Court of Appeals for the Federal Circuit is established under 35 USC §141.

The final decision was mailed on September 21, 2007. A petition for review was timely filed in the U.S. Patent Office and with the Court of Appeals for the Federal Circuit on November 20, 2007, and is therefore timely under 37 CFR §1.304.

The case was docketed by the Federal Circuit on January 7, 2008, making this brief due on March 7, 2008. Federal Circuit rule 31. Hence, this brief is timely filed.

III. Statement of the Issues

The single issue for review is whether non-obviousness, as a result of commercial success, is established by the Declarations under 37 C.F.R. § 1.132 of Mr. Randy Helzer and Mr. Michael Thompson.

IV. Statement of the Case

This is an Ex parte appeal from an examination carried out by the United States Patent Office of application number 09/326,405 for patent. The patent application was examined by the U.S. Patent Office and rejected by the patent examiner. The patent application was eventually appealed to the U.S. Patent and Trademark Office Board of Appeals and Interferences (the "Board") via an Appeal Brief filed in February 23, 2004. An Examiner's Answer was filed on June 2, 2004. A Reply Brief was filed on July 12, 2004. A decision by the Board was finally rendered on October 27, 2006. A Request for Rehearing was filed on December 27, 2006. A final Decision on Request for Rehearing was rendered on September 21, 2007. There is no published version of this decision.

V. Statement of the Facts

The Director of the United States Patent Office, via his delegate(s), finally rejected Appellant's claims 11-13, 15-18, 20-23, 25-28 and 30-33 (A89-93) under 35 USC §103(a) (A83-87) as being unpatentable over Kehne (2,713,896) (A258-264) in view of Lazarek (3,753,458) (A265-268), and claims 14, 19, 24 and 29 (A89-92) under 35 USC §103(a) (A83-87), as being unpatentable over Kehne (2,713,896), in view of Lazarek (3,753,458) and further in view of Jones et al. (5,365,707) (A284-291).

The present claims do not stand rejected on any other ground.

VI. Summary of the Argument

The Board has misconstrued the plain language of the Declarations submitted under 37 C.F.R. § 1.132 by Mr. Randy Helzer (A101-103) and Mr. Michael Thompson (A109-110). The plain language of these Declarations ties the sale of the claimed invention to the contracts mentioned in the Declarations, and specifically identifies that the reasons for the sales were due to the advantages and aesthetic value of the claimed invention. Further, these advantages are not required to be included in the claims, as a matter of law, and are either specifically stated or are inherent in Appellant's disclosure. *Chisum on Patents*, § 5.02[2][f][iii]. Further, a *prima facie* case of nexus to establish commercial success and non-obviousness has been established by the Helzer and Thompson Declarations, since these Declarations specifically tie the reasons for the sale of the claimed invention to the aesthetic value and advantages of the claimed invention. Demaco Corp. v. F. Von Lansdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ 2d 1222 (Fed. Cir. 1988). Further, Appellant is not required to prove, as a part of its *prima facie* case, that the commercial success is not due to factors other than

the patented invention. Demaco Corp. v. F. Von Lansdorff Licensing Ltd., *supra*.

VII. The Argument:

This appeal refers to rejections made in the final decision by the Board on a Request for Rehearing, mailed on September 21, 2007 (“the Decision”) (A1-3).

A. The Examiner and the Board did not properly address the probative value of the evidence presented in the Declarations under 37 C.F.R. 1.132 by Randy Helzer (A101-103) and Michael Thompson (A109-110).

1. The Board, in its Decision, objected to paragraph 15 of the Declaration of Mr. Randy Helzer that states that Point Five Windows “has sold over \$6,300,000 in fifteen major orders of window systems that include the Frameless Velcro Screen System.” (A102) (Emphasis added by the Board.) The Board agrees with the Examiner that there is “no indication what (sic) proportion of the reported figure represents the sale of window systems in accordance with the appealed claims.”

Response by Appellant

The plain language of paragraph 15 states that the sale of \$6,300,000 of window systems includes the Frameless Velcro Screen System. The plain

meaning of this language is that all of the window systems include the Frameless Velcro Screen System. If something is included in an order, that means that it is part of the order. If it is not included, it is not part of the order. Further, paragraph 8 of the Declaration by Randy Helzer clearly states that “the Frameless Velcro Screen System includes all of the limitations of these claims.” (A101) This means that the claimed invention was included in, and made part of, the orders.

2. The Board stated that paragraph 18 of the Declaration by Mr. Randy Helzer “reports a contract in excess of \$720,000 for unspecified windows and doors.” (A102) (Emphasis added.)

Response by Appellant

The contract for \$720,000 is referred to in both paragraphs 18 and 19 of the Declaration by Mr. Helzer (A102). The Board has asserted that the contract is for “unspecified windows.” However, paragraph 19 specifically states that the contract was awarded in large part specifically because the Frameless Velcro Screen System eliminated conventional aluminum screen frames. (A102) In other words, these are not unspecified screen doors or screen windows, since paragraph 19 specifically mentions the Frameless Velcro Screen System, which is the claimed invention, as specified by Mr. Randy Helzer in paragraph 8. (A101)

3. The Board and the Examiner have stated that paragraph 21 of the Declaration by Mr. Helzer “refers to a contract in excess of \$580,000 for ‘casement type windows’ that is due in part to the aesthetic value of the Frameless Velcro Screen Window System.” (A103) (Emphasis added.)

Response by Appellant

Paragraph 21 of the Declaration by Mr. Helzer (A103) clearly indicates that the “casement type windows” referred to in paragraph 21 use the Frameless Velcro Screen System. Paragraph 21 specifically states that the contract “for the casement type windows” was due in part to the “aesthetic value of the Frameless Velcro Screen System.” (A103) The clear meaning of this statement is that, 1) the casement type windows included the Frameless Velcro Screen System, and 2) the contract was awarded, at least in part, due to the aesthetic value of the Frameless Velcro Screen System. There is no indication in paragraph 21 of the Declaration that only a portion of the casement windows included the Frameless Velcro Screen System, or that the casement type windows did not include the Frameless Velcro Screen System. The point of paragraph 21 of the Declaration by Mr. Helzer is that the contract was awarded because of one of the advantages of the claimed invention, i.e., the aesthetic value of the Frameless Velcro Screen System.

4. The Board also states that “although paragraph 11 of the Declaration states that “conventional screen frames with spans in excess of

five feet require support members,” the appeal claims do not recite any particular size of the screen. (A118)

Appellant’s Response

Advantages of the invention, that relate to the reasons why the claimed invention has sold, do not have to be recited in the claims. In In Re Vamco Machine & Tool, Inc., 752 Fed.2d 1564, 224 USPQ 617 (Fed. Cir. 1985), “the Federal Circuit stressed that, to be pertinent to the issue of obviousness, the commercial success of devices falling within a patent’s claims must flow from the functions and advantages disclosed or inherent in the patent specification description of the invention.” (Emphasis added.) See *Chisum on Patents*, § 5.02[2][f][iii], *Unclaimed Features*. In other words, advantages that are disclosed or inherent in the specification of the patent application are certainly pertinent to commercial success of the invention and non-obviousness of the invention, if those advantages flow from the claimed invention. Page 5, lines 4+, of the specification of the application indicates that a “sagging mesh can be easily stretched taught again by pulling the mesh away from the window frame on one side, stretching it tightly and re-attaching it to the window frame.” A245. In other words, sagging of a screen that occurs with conventional aluminum frame screens can be eliminated using the claimed invention, as clearly

spelled out by the specification. It is not necessary that this advantage be recited in the claims.

5. The Board has also agreed with the Examiner that the Declaration of Michael Thompson is flawed, since it "vaguely refers to a contract 'for numerous windows for a residence project.'" A18.

Appellant's Response

First, paragraph 3 of the Declaration by Michael Thompson states that he "worked with Mr. Randy Helzer of Point Five Windows on the... residence project." A109. Clearly, the project that is mentioned by Mr. Randy Helzer "in excess of \$580,000" in paragraph 21 of Mr. Randy Helzer's Declaration (A103) is the same contract that is mentioned in paragraph 2 of the Michael Thompson Declaration "in excess of \$580,000.00." A109. Secondly, the contract for \$580,000, as pointed out above, used the Frameless Velcro Screen System (i.e., the claimed invention). Further, paragraph 4 of the Michael Thompson Declaration specifically states that "Point Five Windows used a Frameless Velcro Screen System on...the residence project" for the numerous casement windows. A109. Clearly, the numerous casement windows included the Frameless Velcro Screen System, as indicated in both the Declaration of Michael Thompson and Declaration of Mr. Randy Helzer.

B. The Declarations by Mr. Randy Helzer and Mr. Michael Thompson properly establish “a *prima facie* case of nexus” to establish commercial success and non-obviousness pursuant to Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ 2d 1222 (Fed. Cir. 1988).

1. The Board has taken the position that both the Thompson Declaration and the Helzer Declaration “falls (sic) short of convincingly demonstrating the requisite nexus between the asserted commercial success in the window systems, within the scope of the appealed claims. Ex parte Remark, 15 USPQ 2d 1498, 1502” (Bd. Pat. App. & Int. 1990). A18-19.

Appellant’s Response

Ex parte Remark, *supra*, stands for the proposition that when an applicant in an Ex parte proceeding attempts to show commercial success, that the sale of a product or process is “due to the merits of the claimed invention.” (Emphasis added.) This is exactly what has occurred in both the Declarations of Mr. Randy Helzer and Mr. Michael Thompson. The Helzer Declaration states “[t]hat the Frameless Velcro Screen System has specific advantages over conventional frame screens that are competitive (sic) advantage for our company, as a licensee.” A101. Paragraph 10 states “[T]hat one of the competitive advantages of the Frameless Velcro Screen System is that the screen frames are eliminated from the window system.”

A102. (Emphasis added.) Paragraph 11 states “[T]hat conventional screen frames, with spans in excess of five feet, require support members to prevent the conventional screen frames from sagging or bowing into the viewing area, and such conventional screen frames are highly susceptible to damage during installation.” A102. (Emphasis added.) The Helzer Declaration therefore establishes that the claimed invention has competitive advantages and specifically identifies that the claimed invention has been successfully sold as a result of these competitive advantages, i.e., that the aluminum frame around the screen is eliminated and that support members are not required to prevent sagging.

Paragraphs 13 and 14 of the Helzer Declaration identify an advantage of the claimed invention that the Frameless Velcro Screen System can be used for “curved or other oddly shaped profiles.” A102. (Emphasis added.) Paragraphs 16 and 17 of the Helzer Declaration indicate an advantage of the claimed invention over aluminum frame screens “in salt spray,” due to the fact that conventional screen frames “may corrode when exposed to salt water spray.” A102. (Emphasis added.)

Paragraphs 18 and 19 of the Helzer Declaration state that a contract in excess of \$720,000 was entered into “in a saltwater environment in the Bahamas” and that the contract “was awarded in large part specifically because the Frameless Velcro System eliminated the conventional aluminum

screen frame that would have been susceptible to deterioration in the harsh salt air environment of the Bahamas." A102. (Emphasis added.) Hence, these advantages of the claimed invention over the prior art have been identified in the Helzer Declaration were identified as "specifically" resulting in sales. A102.

Clearly, each of these statements addresses the "merits of the claimed invention" and the advantages of the claimed invention that are either disclosed or inherent in the disclosure of the application. Ex parte Remark, supra.

Further, paragraph 15 indicates that between 1998 and 2003, when the Helzer Declaration was executed, there were over \$6,300,000 in sales in window systems that included the claimed invention. A102. These are significant sales for a small company such as Point Five Windows.

Further, the Declaration of Michael Thompson indicates that he was an architect at Lipkin Warner Design and Planning of Basalt, Colorado (paragraph 1) (A109) and that he "specifically did not want a conventional screen having a frame that is typically mounted on a casement window" for the \$580,000 project that used the claimed invention (paragraph 8). A109. (Emphasis added.) Further, Mr. Michael Thompson states that the award of the contract that included the screens of the claimed invention was due in part because the use of the claimed invention "offered aesthetic and

functional differences over any other known solution" (paragraphs 7 and 9).

A109. (Emphasis added.)

Again, the "merits" of the claimed invention are specifically spelled out in the Declaration by Mr. Michael Thompson, in accordance with Ex parte Remark, supra.

3. The establishment of a *prima facie* case of nexus does not require Appellant to prove a negative.

The Board further stated, "[F]urthermore, we agree with the examiner that the Declaration evidence fails to establish any commercial success was due to the merits of the claimed invention, rather than other activities on the part of the present assignee, e.g., advertising, sales campaigns and associations with established customers. See Cable Elec. Prod. Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-1027, 226 USPQ 881, 888 (Fed. Cir. 1985)." A19.

Cable Elec. Prod. v. Genmark, Inc., supra, does not stand for the proposition that Appellant must prove a negative, i.e., that commercial success was not due to advertising, sales campaigns, or associations with established customers. Cable Elec. Prod. v. Genmark, Inc., supra, did not so hold, and it is a misconstruction by the Board to assert that Applicant must prove that the commercial success was not due to those factors, even in an Ex parte application.

Rather, the established precedent is set forth in Ex parte Remark, supra, wherein the court cites Demaco Corp. v. F. VonLangsdorff Licensing Limited, 851 Fed.2d 1387, 7 USPQ 2d 1222 (Fed Cir. 1988).

A patentee is not required to prove as a part of its *prima facia* case that the commercial success is *not* due to factors other than the patented invention. (Emphasis in the original.)

Hence, the statement by the Board is incorrect. Appellant has established “a *prima facie* case of nexus” by showing a commercial success of the claimed invention and that the commercial success was due to the merits of the claimed invention, i.e., the advantages of the claimed invention over the prior art that are both disclosed and inherent in Appellant’s disclosure.

Demaco Corp. v. F. Von Langsdorff Licensing Ltd., supra.

VIII. Conclusion and Statement of Relief Sought

In conclusion, non-obviousness of the claimed invention has been established as a result of the commercial success that has been set forth in the Declarations under 37 C.F.R. § 1.132 by Mr. Randy Helzer and Mr. Michael Thompson. The Declarations establish a *prima facie* case of nexus by showing both the commercial success of the claimed invention and that the commercial success was due to the merits of the claimed invention. The

Declarations specifically set forth that the merits of the invention, i.e., the advantages of the claimed invention over the prior art, were the specific reason for the successful sales of the invention.

Appellant requests that the Court reverse the Decision of the Board.

Dated: March 5, 2008



William W. Cochran

William W. Cochran

IX. Proof of Service

United States Court of Appeals for the Federal Circuit

In Re Lundahl
2008-1151

The undersigned hereby certifies that two copies of the attached APPELLANT'S BRIEF AND ADDENDUM were sent today via first class mail to:

Office of the Solicitor
United States Patent and Trademark Office,
P.O. Box 15667
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X. Certificate of Compliance (Federal Rule 32)

The undersigned hereby certifies that this brief has fewer than 14,000 words (in fact, 2,887 words), as counted by the word processing software.

Dated: March 5, 2008


William W. Cochran

ADDENDUM

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The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVE B. LUNDAHL

Appeal 2006-1417
Application 09/326,405
Technology Center 3600

Decided: September 21, 2007

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
CHARLES F. WARREN, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of our Decision of October 27, 2006,
wherein we sustained the Examiner's final rejection of claims 11-13 under
35 U.S.C. § 103(a).

We have thoroughly reviewed Appellant's Request but we do not
subscribe to Appellant's position that we misapprehended or overlooked the
points made in the Request. In our view, the arguments made by Appellant

Appeal 2006-1417
Application 09/326,405

in the Request were fully considered in reaching our decision that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art.

Appellant poses the question "what motivation would there be for someone skilled in the art to replace a framed screen which can be installed and removed from the inside of the house with some difficulty, with an unframed screen that is designed to be easily removed from the inside when mounted on the inside of a window frame, but would be more difficult to remove and install when mounted on the exterior of a window frame?" (Request 5, first para.). However, the motivation expressed by Appellant is misplaced and misses the thrust of our reasoning in support of the legal conclusion of obviousness for the claimed subject matter. Lazarek evidences that it was known in the art to employ the well-known, conventional hook and loop fasteners for securing a window screen to a structure. Therefore, we concluded, and remain of the opinion, that one of ordinary skill in the art would have found it obvious to modify the window system of Kehne so as to utilize such conventional hook and loop fasteners to provide easy and quick mounting and dismounting of the screen. We perceive nothing nonobvious in substituting one known securing means for another when both means were known for securing a window screen to a structure, and Appellant has advanced no reason why such a modification would have been nonobvious to one of ordinary skill in the art.

Appeal 2006-1417
Application 09/326,405

As for the Declaration evidence relied upon by Appellant, we are not convinced that the probative value we accorded the Declaration evidence was in error. We adhere to our judgment that the evidence of obviousness presented by the Examiner outweighs the evidence of nonobviousness proffered by Appellant.

In conclusion, based on the foregoing, we have granted Appellant's request to reconsider our decision, but we deny the request with respect to making any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

clj

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Dave B. Lundahl

Examiner: Tran A, Phi Dieu N

Serial No.: 09/326,405

Group Art Unit: 3637

Filed: June 4, 1999

Docket: INOV.01US01

Title: IMPROVED WINDOW SCREEN SYSTEM

Mail Stop Appeal Brief - Patents
Assistant Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING

Honorable Board of Appeals:

In response Appeal No. 2006-1417 decided October 27, 2006, wherein the Board of Appeals affirmed the Examiner's rejection of the appealed claims, appellant requests rehearing of the Decision on Appeal.

Appellant respectfully believes that the following matters have been misapprehended or overlooked in the Board's decision:

**1. THE EXAMINER HAS FAILED TO UNDERSTAND THE TEACHINGS
OF THE KEHNE REFERENCE.**

The Board has overlooked this argument in its Decision.

In Section 10, paragraph 2 of the Supplemental Examiner's Answer, the Examiner concluded that: "... it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kehne to show the screen

being attached to the frame by hook and loop fastener because it would enable easy fitting of the screen frame around a window frame as taught by Lazarek."

On page 3 of appellant's Supplemental Reply Brief filed on November 14, 2005, appellant stated: "In Col. 1, lines 41-45 of Kehne, the window is defined as a composite casement including a fixed frame with hinged sash, wherein the frame may be completely assembled for shipment as a composite unit for installation. In Col. 2, lines 43-44, Kehne further defines the window as the fixed frame **11** in Figs. 1 and 2. In Col. 3, lines 26-40, Kehne defines the screen as fitting inside of frame **11** and seated against the outer edges of other independently applied wall construction elements that Kehne identifies as jambs **25**. Kehne further confirms that the jamb elements are independent from the window frame of Kehne in Col. 3, lines 52-56. Figures 1 and 2 clearly show that jambs **25** are building construct elements which surround Kehne's window, but are not part of the window itself; jambs **25** are illustrated with the same hatch markings as other wall sheathing **7** and wall covering **8**, instead of the hatch markings utilized to identify window components, **11** and **16**. Moreover, the components of fixed frame, **11**, are defined in Col. 2, lines 42-51, of Kehne, and do not include jambs **25**. Thus, the Examiner is incorrect in stating that '... the screen being attached to the frame by hook and loop fastener ...'. Since Lazarek requires that the demountable screen be mounted around what would be considered to be the frame of the sliding car window, while Kehne does not mount the screen frame to the window frame, applicant believes that the two references teach away from one another; that is, Kehne mounts the screen disclosed therein to structures other than the window frame. Applicant therefore believes that the Examiner has improperly combined the Kehne and Lazarek references, and thereby failed to make a proper *prima facie* showing of obviousness."

Appellant therefore respectfully believes that the Examiner has not fully understood the teachings of the Kehne reference, and has improperly combined Lazarek with Kehne.

2. WHAT MOTIVATION WOULD THERE BE FOR SOMEONE SKILLED IN THE ART TO PLACE A SCREEN WHICH CAN READILY BE INSTALLED AND REMOVED FROM THE INSIDE OF A WINDOW FRAME IN A LOCATION IN WHICH IT CANNOT READILY BE INSTALLED OR REMOVED?

The Board has misapprehended this matter in its Decision.

On page 4 of the Decision, the Board stated that: "Appellant contends that the references are not combinable because Kehne mounts the screen on the exterior portion of the window whereas Lazarek mounts the screen to the interior portion of the window. However, it is well settled that it is not necessary for a finding of obviousness under § 103 that all the features of one reference be incorporated with the features of another reference. *In re Griver*, 354 F.2d 377, 381, 148 USPQ 197, 200 (CCPA 1966); *In re Billingsley*, 279 F.2d 689, 691, 126 USPQ 370, 372 (CCPA 1960). The relevant question is what would the collective teachings of the references have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In the present case, we are satisfied that the collective teachings of Kehne and Lazarek would have suggested the use of hook and loop fasteners for removably connecting the screen of Kehne to the fixed frame. While Appellant maintains that Kehne teaches a permanently mounted screen, we agree with the Examiner that Kehne's disclosure of supporting a screen 'in a more or less permanent manner' would have suggested a screen that is ultimately removable (see col. 1, ll. 60-62). Furthermore, we agree with the Examiner that it was notoriously well known in the art to provide removable screens in the fixed frame of a window. Applicant also maintains that Lazarek 'clearly does not suggest any method for 'mounting the screen in a permanent manner' as set forth in Appellant's claims (principal Br. 7, second paragraph). This argument is not germane to the claimed subject matter since the quoted recitation is not found in the appealed claims. Indeed, rather than calling for mounting the screen in a permanent manner, the claims recite a removable screen."

Assuming for argument that the screen of Kehne is mounted to the exterior of the frame of the window (That is, ignoring for purposes of discussion that the screen of Kehne is not mounted on the window frame thereof.), appellant believes that Kehne intended that the screen be removable for servicing, but otherwise affixed to the frame. There is no discussion of the manner in which the screen is held in place in Kehne, but screens installed on the exterior of casement window frames are not readily removed or installed from the inside. According to the American Heritage Dictionary of The English Language, 3rd Ed. (Houghton Mifflin Company, Boston, New York 1992), the principal definition for "more or less" is "about" or "approximately." Therefore, applicant respectfully believes that the screen of Kehne is intended to remain in place.

In Col. 1, lines 20-27, of Lazarek it is stated that: "Permanently attached screens to the automobile windows are undesirable in that they impair visibility and are probably not necessary in view of the fact that insect annoyance is a serious problem only when the automobile is parked, because when the vehicle is moving the rush of air past the vehicle is sufficient to prevent insects from entering a moving automobile." Lazarek continues in Col. 2, lines 20-27, that: "Accordingly, it is an object of this invention to provide a screen for a car window that may be demountably installed without the use of tools, without defacing the window frame, which is neat and inconspicuous in appearance, which may be stored in a minimum of space when not in use, and which does not interfere with the normal operation of the automobile window." Thus, Lazarek teaches the infrequent use of nonpermanent screens which can be stored in a minimum of space, but which can be readily installed and removed.

As stated hereinabove, exterior-mounted framed screens may be removed from casement windows from the inside of a house with some difficulty depending on how they are mounted. However, how can one easily attach male and female portions of Velcro tape located exterior to a window frame from the inside? Therefore, appellant believes that it clearly matters that the screen of Lazarek is

installed on the inside of a window frame if it is going to be frequently installed and removed. Further, appellant questions what motivation would there be for someone skilled in the art to replace a framed screen which can be installed and removed from the inside of the house with some difficulty, with an unframed screen that is designed to be easily removed from the inside when mounted on the inside of a window frame, but would be more difficult to remove and install when mounted on the exterior of a window frame? Clearly, the combination of Lazarek with Kehne, as suggested by the Examiner, is an attempt to reconstruct appellant's invention using impermissible hindsight.

3. HOW CAN ONE ATTACH A SCREEN TO THE WINDOW OF KEHNE WHICH IS LARGER THAN THE OPENING IN THE WINDOW FRAME?

The Board has overlooked this argument in its Decision.

On pages 2 and 3 of appellant's Supplemental Reply Brief filed on November 14, 2005, appellant stated: "Turning now to the first line of the Abstract, Col. 1, lines 44-45, Col. 3, lines 24-27, and claim 1, lines 3-4, of Lazarek clearly emphasize that the sheet of screening is to be somewhat larger than the window. Moreover, Col 3, lines 9-11, calls for canvas belting extending beyond the periphery of the screen to form a tab. This permits the screen of Lazarek to be mounted over the car window (Col. 1, lines 60-61). Kehne, in Col. 3, lines 34-40, requires that the outer edges of the jambs be spaced inwardly from the inner face of the sash frame in order to provide a seat for the frame of a window screen. From Figs. 1 and 2 it may be observed that the window screen frame is disposed inside of the perimeter of the fixed frame (the components of fixed frame, 11, are defined in Col. 2, lines 42-51) of Kehne. Kehne further requires in Figs. 1 and 2 and in Col. 3, lines 11-15, that weather stripping secured to the inner surface of the sash frame is adapted to seat in the bottoms of the grooves in the outer surface of the fixed frame. If one were to combine the teachings of Lazarek, which stress an oversized screen (one larger than the perimeter of the window panel and, as a

result, larger than the perimeter of the window frame of Lazarek), with Kehne which, by contrast, requires a screen frame and consequently a screen that is smaller than the perimeter of the fixed frame, the weather stripping secured to the inner surface of the sash frame of Kehne could not properly seat in the bottoms of the grooves provided therefor in the stationary frame. Thus, the combination of Lazarek with Kehne, as the Examiner has suggested, renders the invention of Kehne inoperative. As stated in previous papers, Kehne and Lazarek disclose the use of screens in different locations with respect to the window, and for different window designs. There is little to restrict the oversize dimensions of the screen disclosed by Lazarek, since the operation of the window is unaffected thereby. By contrast, screen dimensions are important for Kehne, since the proper operation of the sash frame would be impaired by a screen constructed in accordance with Lazarek."

Thus, appellant believes that the Board has overlooked another of the reasons one having ordinary skill would not be motivated to combine the teachings of Lazarek with those of Kehne to render obvious the present claimed invention.

Moreover, Section 2145 of the Manual of Patent Examining Procedure states that: "It is improper to combine references where the references teach away from their combination." Since Lazarek teaches away from Kehne, appellant believes that the Examiner has improperly combined these references, and thereby failed to make a proper *prima facie* showing of obviousness.

4. THE HELZER DECLARATION IS MORE SPECIFIC THAN THE EXAMINER HAS INDICATED.

The Board has overlooked this issue in its Decision.

On pages 5 and 6 of the Decision, the Board stated that: "Appellant relies on Helzer and Thompson Declarations under 37 C.F.R. § 1.132 as evidence of commercial success. However, we find that the Examiner has lodged valid

criticisms regarding the weight of the Declaration evidence. For instance, the Declaration of Helzer, the Vice President for Marketing and Sales for the present assignee, states in paragraph 15, that Five Point Windows, the exclusive licensee of a window system in accordance with the appealed claims, 'has sold over \$6,300,000 in 15 major orders of window systems that include the Frameless Velcro Screen System (emphasis added). As pointed out by the Examiner, there is no indication what proportion of the reported figure represents the sale of window systems in accordance with the appealed claims. Similarly, paragraph 18 of the Declaration reports a contract in excess of \$720,000 for unspecified windows and doors, while paragraph 21 of the Declaration refers to a contract in excess of \$580,000 for "casement type windows" that is 'due in part to the aesthetic value of the Frameless Velcro Screen System' (emphasis added). Also, while paragraph 22 of the Declaration states that the \$580,000 contract was specifically entered 'because the screen was mounted between the fixed frame and the moving sash, for a casement window,' the Examiner correctly points out that the window system of Kehne has the screen mounted between the fixed frame and the moving sash."

However, appellant respectfully points out, it was not the casement windows of Kehne that were selected; rather, the claimed Frameless Velcro Screen System of the present claimed invention was selected. Further, Paragraph 23 of the Helzer Declaration states: "That the architect specifically did not want a conventional screen frame that is typically mounted on the exterior frame of an in-swing casement window;". This is a direct affirmation of the already stated reasons that the present claimed invention was the cause of the commercial success of the Point Five Windows. Additionally, Paragraph 19 of the Helzer Declaration states that: "That the \$720,000.00 contract was awarded in large part specifically because the Frameless Velcro Screen System eliminated the conventional aluminum screen frame that would have been susceptible to deterioration in the harsh salt air environment of the Bahamas;" Appellant believes that this latter statement is dispositive on the issue that the Frameless

Velcro Screen System was specifically chosen to avoid attack on the frame as a result of proximity of the windows to the ocean, because of the "in large part" language thereof.

Additionally, In the Declaration Under 37 CFR 1.132 by Michael Thompson, it is clearly stated that the subject thereof is a casement window having a removable screen connected to the fixed frame with a hook and loop fastener system. This feature is not disclosed by the Kehne patent, and it was the recommendation of Mr. Thompson to Lipkin Warner Design and Planning, LLC which led to the purchase of a significant number of Point Five Windows having the Frameless Velcro Screen System. This recommendation was clearly based on the aesthetic and functional differences of the Point Five Windows having the Frameless Velcro Screen System over any known windows.

5. THE THOMPSON DECLARATION IS MORE SPECIFIC THAN THE EXAMINER HAS INDICATED.

The Board has overlooked this issue in its Decision.

On pages 6 and 7 of the Decision, the Board stated that: "The Declaration of Michael Thompson, an architect who supported a contract in excess of \$580,000 to the present assignee, is similarly flawed. Paragraph 2 of the Declaration vaguely refers to the contract 'for numerous windows for a residence project.' Furthermore, in paragraph 7, the Declarant states that the contract was awarded 'due in part' to the window system of the present invention. Manifestly, the Thompson Declaration, as well as the Helzer Declaration, falls short of convincingly demonstrating the requisite nexus between the asserted commercial success and window systems within the scope of the appealed claims. *Ex Parte Remark*, 15 USPQ2d 1498, 1502 (Bd. Pat. App. & Inf. 1990). Furthermore, we agree with the Examiner that the Declaration evidence fails to establish that any commercial success was due to the merits of the claimed

invention rather than other activities on the part of the present assignee, e.g., advertising, sales campaigns, and associations with established customers."

Appellant wishes to point out that Paragraphs 8 and 9 of the Thompson Declaration state: "That I specifically did not want a conventional screen having a frame that is typically mounted on a casement window for the above mentioned project;" and "That Lipkin Warner Design and Planning, LLC supported the \$580,000.00 contract award to Point Five Windows based in part on the fact that the Frameless Velcro Screen System offered aesthetic and functional differences over any other known solution, which included conventional screen frames;". Thus, appellant believes that the very words of the architect identifies the reason for the choice of the Frameless Velcro Screen System of the present claimed invention; namely, the architect did not want a conventional screen having a frame.

Appellant therefore requests rehearing of the Decision on Appeal.

Dated this 27th day of December 2006.

Respectfully submitted,

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The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVE B. LUNDAHL

Appeal 2006-1417
Application 09/326,405
Technology Center 3600

Decided: October 27, 2006

Before KIMLN, GARRIS, and WARREN, *Administrative Patent Judges*.
KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 11-33. Claim 11 is illustrative:

11. An operable window system with a removable screen comprising:
 - a fixed frame;
 - a moving sash connected to said fixed frame and operable to substantially swing about an axis with respect to said fixed frame from an open position to a closed position; and

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Application 09/326,405

a removable screen without a substantially rigid peripheral frame removably connected to said fixed frame with hook and loop fasteners, said removable screen mounted between said fixed frame and said moving sash.

The Examiner relies upon the following references as evidence of obviousness:

| | | |
|---------|--------------|---------------|
| Kehne | US 2,713,896 | Jul. 26, 1955 |
| Lazarek | US 3,753,458 | Aug. 21, 1973 |
| Jones | US 5,365,707 | Nov. 22, 1994 |

Appellant's claimed invention is directed to an operable window system comprising a fixed frame, a moving sash connected to the frame and operable to swing from an open position to a closed position, and a removable screen that is mounted between the fixed frame and the moving sash. The screen is without a substantially rigid peripheral frame and is connected to the fixed frame with hook and loop fasteners.

Appealed claims 11-13, 15-18, 20-23, 25-28, and 30-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kehne in view of Lazarek. Claims 14, 19, 24, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the stated combination of references further in view of Jones.

Appellant provides separate arguments for claims 20 and 25, as a group. Accordingly, claims 11-13, 15-18, 21-23, 26-28, and 30-33 stand or fall together as a group, as do separately rejected claims 14, 19, 24, and 29.

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Application 09/326,405

We have thoroughly reviewed each of Appellant's arguments for patentability, as well as the declaration evidence relied upon in support thereof. However, we are in complete agreement with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the Examiner's rejections for the reasons set forth in the Answer, which we incorporate herein, and we add the following primarily for emphasis.

Appellant does not contest the Examiner's factual determination that Kehne, like Appellant, discloses an operable window system comprising a fixed frame, a moving sash operable to substantially swing about an axis with respect to the fixed frame from an open position to a closed position, and a screen that is mounted between the fixed frame and the moving sash. As recognized by the Examiner, Kehne does not disclose that the screen is connected to the fixed frame with hook and loop fasteners. However, as explained by the Examiner, Lazarek discloses a removable window screen that is attached to the window's fixed frame with hook and loop fasteners which provide easy and quick mounting and dismounting of the screen. Accordingly, based on the collective teachings of Kehne and Lazarek, we concur with the Examiner that it would have been obvious for one of ordinary skill in the art to employ the hook and loop fasteners of Lazarek in the window system of Kehne to provide the described advantage of enabling the screen to be readily mounted and dismounted. We also find that one of

ordinary skill in the art would have appreciated any savings in cost associated with replacing an aluminum frame with a periphery of hook and loop fasteners.

Appellant contends that the references are not combinable because Kehne mounts the screen on the exterior portion of the window whereas Lazarek mounts the screen to the interior portion of the window. However, it is well settled that it is not necessary for a finding of obviousness under § 103 that all the features of one reference be incorporated with the features of another reference. *In re Griver*, 354 F.2d 377, 381, 148 USPQ 197, 200 (CCPA 1966); *In re Billingsley*, 279 F.2d 689, 691, 126 USPQ 370, 372 (CCPA 1960). The relevant question is what would the collective teachings of the references have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In the present case, we are satisfied that the collective teachings of Kehne and Lazarek would have suggested the use of hook and loop fasteners for removably connecting the screen of Kehne to the fixed frame. While Appellant maintains that Kehne teaches a permanently mounted screen, we agree with the Examiner that Kehne's disclosure of supporting a screen "in a more or less permanent manner" would have suggested a screen that is ultimately removable (see col. 1, ll. 60-62). Furthermore, we agree with the Examiner that it was notoriously well known in the art to provide removable screens in the fixed frame of a window.

Appellant also maintains that Lazarek "clearly does not suggest any method for 'mounting the screen in a permanent manner' as set forth in Appellant's claims" (principal Br. 7, second paragraph). This argument is not germane to the claimed subject matter since the quoted recitation is not found in the appealed claims. Indeed, rather than calling for mounting the screen in a permanent manner, the claims recite a removable screen.

Appellant also makes the argument that:

Claims 20 and 25 recite an additional limitation in which the removable screen is mounted between the fixed frame and the moving sash such that the moving sash is in contact with the removable screen when the moving sash is in the closed position such that the hook and loop fastener is engaged.

(principal Br. 8, second paragraph). However, as accurately noted by the Examiner, Figure 3 of Kehne "shows the sash touching the screen when the sash is in the closed position" (Supp. Answer 8, last paragraph).

As for the separately argued claims directed to the window system being non-rectangular, we concur with the Examiner that Jones evidences the obviousness of making windows of various shapes.

Appellant relies upon the Helzer and Thompson Declarations under 37 C.F.R. § 1.132 as evidence of commercial success. However, we find that the Examiner has lodged valid criticisms regarding the weight of the Declaration evidence. For instance, the Declaration of Helzer, the Vice President for Marketing and Sales for the present assignee, states in paragraph 15 that Point Five Windows, the exclusive licensee of a window system in accordance with the appealed claims, "has sold over \$6,300,000 in

15 major orders of window systems that include the Frameless Velcro Screen System" (emphasis added). As pointed out by the Examiner, there is no indication what proportion of the reported figure represents the sale of window systems in accordance with the appealed claims. Similarly, paragraph 18 of the Declaration reports a contract in excess of \$720,000 for unspecified windows and doors, while paragraph 21 of the Declaration refers to a contract in excess of \$580,000 for "casement type windows" that is "due in part to the aesthetic value of the Frameless Velcro Screen System" (emphasis added). Also, while paragraph 22 of the Declaration states that the \$580,000 contract was specifically entered "because the screen was mounted between the fixed frame and moving sash for a casement window," the Examiner correctly points out that the window system of Kehne has the screen mounted between the fixed frame and the moving sash. In addition, although paragraph 11 of the Declaration states that "conventional screen frames with spans in excess of five feet require support members," the appealed claims do not recite any particular size for the screen.

The Declaration of Michael Thompson, an architect who supported a contract in excess of \$580,000 to the present assignee, is similarly flawed. Paragraph 2 of the Declaration vaguely refers to the contract "for numerous windows for a residence project." Furthermore, in paragraph 7, the Declarant states that the contract was awarded "due in part" to the window system of the present invention. Manifestly, the Thompson Declaration, as well as the Helzer Declaration, falls short of convincingly demonstrating the

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Application 09/326,405

requisite nexus between the asserted commercial success and window systems within the scope of the appealed claims. *Ex parte Remark*, 15 USPQ2d 1498, 1502 (Bd. Pat. App. & Int. 1990).

Furthermore, we agree with the Examiner that the Declaration evidence fails to establish that any commercial success was due to the merits of the claimed invention rather than other activities on the part of the present assignee, e.g., advertising, sales campaigns, and associations with established customers. *See Cable Elec. Prod. Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27, 226 USPQ 881, 888 (Fed. Cir. 1985).

Accordingly, it is our judgment that Appellant's evidence of nonobviousness, including the Declaration evidence of commercial success, does not outweigh the evidence of obviousness presented by the Examiner. *In re Rynkiewicz*, 390 F.2d 742, 746, 156 USPQ 462, 465 (CCPA 1968).

In conclusion, based on the foregoing and the reasons well stated by the Examiner, the Examiner's decision rejecting the appealed claims is affirmed.

Appeal 2006-1417
Application 09/326,405

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2004).

AFFIRMED

clj

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Dave B. Lundahl v. United States Patent and Trademark Office
No. 2008-1151

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)

Dave B. Lundahl certifies the following (use "None" if applicable; use extra sheets if necessary):

1. The full name of every party or amicus represented by me is:

Dave B. Lundahl

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

Dave B. Lundahl, Ann Lundahl, Travis Lundahl, Nicole Clark and Inovadeas, LLLP, a Colorado limited liability limited partnership

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

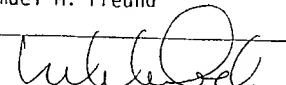
None

4. There is no such corporation as listed in paragraph 3.

5. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

William W. Cochran, James R. Young, Samuel M. Freund
Cochran Freund & Young LLC

February 5, 2008
Date



Signature of counsel

William W. Cochran
Printed name of counsel

Reset Fields

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TREATISES

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I. Statement of Related Cases

There are no related cases pending before this or any other tribunal.

II. Jurisdictional Statement

This appeal is from the Decision on Appeal of the United States Patent and Trademark Office dated October 27, 2006, pages A13-21 of the Joint Appendix, and the Decision on Request for Rehearing, pages A1-3. The United States Patent Office has original jurisdiction of the patent application under 35 USC §2. The Decision on Rehearing was a “final decision” of the Agency. Jurisdiction by the Court of Appeals for the Federal Circuit is established under 35 USC §141.

The final decision was mailed on September 21, 2007. A petition for review was timely filed in the U.S. Patent Office and with the Court of Appeals for the Federal Circuit on November 20, 2007, and is therefore timely under 37 CFR §1.304.

The case was docketed by the Federal Circuit on January 7, 2008, making this brief due on March 7, 2008. Federal Circuit rule 31. Hence, this brief is timely filed.

III. Statement of the Issues

The single issue for review is whether non-obviousness, as a result of commercial success, is established by the Declarations under 37 C.F.R. § 1.132 of Mr. Randy Helzer and Mr. Michael Thompson.

IV. Statement of the Case

This is an Ex parte appeal from an examination carried out by the United States Patent Office of application number 09/326,405 for patent. The patent application was examined by the U.S. Patent Office and rejected by the patent examiner. The patent application was eventually appealed to the U.S. Patent and Trademark Office Board of Appeals and Interferences (the “Board”) via an Appeal Brief filed in February 23, 2004. An Examiner’s Answer was filed on June 2, 2004. A Reply Brief was filed on July 12, 2004. A decision by the Board was finally rendered on October 27, 2006. A Request for Rehearing was filed on December 27, 2006. A final Decision on Request for Rehearing was rendered on September 21, 2007. There is no published version of this decision.

V. Statement of the Facts

The Director of the United States Patent Office, via his delegate(s), finally rejected Appellant’s claims 11-13, 15-18, 20-23, 25-28 and 30-33 (A89-93) under 35 USC §103(a) (A83-87) as being unpatentable over Kehne (2,713,896) (A258-264) in view of Lazarek (3,753,458) (A265-268), and claims 14, 19, 24 and 29 (A89-92) under 35 USC §103(a) (A83-87), as being unpatentable over Kehne (2,713,896), in view of Lazarek (3,753,458) and further in view of Jones et al. (5,365,707) (A284-291).

The present claims do not stand rejected on any other ground.

VI. Summary of the Argument

The Board has misconstrued the plain language of the Declarations submitted under 37 C.F.R. § 1.132 by Mr. Randy Helzer (A101-103) and Mr. Michael Thompson (A109-110). The plain language of these Declarations ties the sale of the claimed invention to the contracts mentioned in the Declarations, and specifically identifies that the reasons for the sales were due to the advantages and aesthetic value of the claimed invention. Further, these advantages are not required to be included in the claims, as a matter of law, and are either specifically stated or are inherent in Appellant's disclosure. *Chisum on Patents*, § 5.02[2][f][iii]. Further, a *prima facie* case of nexus to establish commercial success and non-obviousness has been established by the Helzer and Thompson Declarations, since these Declarations specifically tie the reasons for the sale of the claimed invention to the aesthetic value and advantages of the claimed invention. Demaco Corp. v. F. Von Lansdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ 2d 1222 (Fed. Cir. 1988). Further, Appellant is not required to prove, as a part of its *prima facie* case, that the commercial success is not due to factors other than

the patented invention. Demaco Corp. v. F. Von Lansdorff Licensing Ltd., *supra*.

VII. The Argument:

This appeal refers to rejections made in the final decision by the Board on a Request for Rehearing, mailed on September 21, 2007 ("the Decision") (A1-3).

A. The Examiner and the Board did not properly address the probative value of the evidence presented in the Declarations under 37 C.F.R. 1.132 by Randy Helzer (A101-103) and Michael Thompson (A109-110).

1. The Board, in its Decision, objected to paragraph 15 of the Declaration of Mr. Randy Helzer that states that Point Five Windows "has sold over \$6,300,000 in fifteen major orders of window systems that include the Frameless Velcro Screen System." (A102) (Emphasis added by the Board.) The Board agrees with the Examiner that there is "no indication what (sic) proportion of the reported figure represents the sale of window systems in accordance with the appealed claims."

Response by Appellant

The plain language of paragraph 15 states that the sale of \$6,300,000 of window systems includes the Frameless Velcro Screen System. The plain

meaning of this language is that all of the window systems include the Frameless Velcro Screen System. If something is included in an order, that means that it is part of the order. If it is not included, it is not part of the order. Further, paragraph 8 of the Declaration by Randy Helzer clearly states that “the Frameless Velcro Screen System includes all of the limitations of these claims.” (A101) This means that the claimed invention was included in, and made part of, the orders.

2. The Board stated that paragraph 18 of the Declaration by Mr. Randy Helzer “reports a contract in excess of \$720,000 for unspecified windows and doors.” (A102) (Emphasis added.)

Response by Appellant

The contract for \$720,000 is referred to in both paragraphs 18 and 19 of the Declaration by Mr. Helzer (A102). The Board has asserted that the contract is for “unspecified windows.” However, paragraph 19 specifically states that the contract was awarded in large part specifically because the Frameless Velcro Screen System eliminated conventional aluminum screen frames. (A102) In other words, these are not unspecified screen doors or screen windows, since paragraph 19 specifically mentions the Frameless Velcro Screen System, which is the claimed invention, as specified by Mr. Randy Helzer in paragraph 8. (A101)

3. The Board and the Examiner have stated that paragraph 21 of the Declaration by Mr. Helzer “refers to a contract in excess of \$580,000 for ‘casement type windows’ that is due in part to the aesthetic value of the Frameless Velcro Screen Window System.” (A103) (Emphasis added.)

Response by Appellant

Paragraph 21 of the Declaration by Mr. Helzer (A103) clearly indicates that the “casement type windows” referred to in paragraph 21 use the Frameless Velcro Screen System. Paragraph 21 specifically states that the contract “for the casement type windows” was due in part to the “aesthetic value of the Frameless Velcro Screen System.” (A103) The clear meaning of this statement is that, 1) the casement type windows included the Frameless Velcro Screen System, and 2) the contract was awarded, at least in part, due to the aesthetic value of the Frameless Velcro Screen System. There is no indication in paragraph 21 of the Declaration that only a portion of the casement windows included the Frameless Velcro Screen System, or that the casement type windows did not include the Frameless Velcro Screen System. The point of paragraph 21 of the Declaration by Mr. Helzer is that the contract was awarded because of one of the advantages of the claimed invention, i.e., the aesthetic value of the Frameless Velcro Screen System.

4. The Board also states that “although paragraph 11 of the Declaration states that “conventional screen frames with spans in excess of

five feet require support members,” the appeal claims do not recite any particular size of the screen. (A118)

Appellant’s Response

Advantages of the invention, that relate to the reasons why the claimed invention has sold, do not have to be recited in the claims. In In Re Vamco Machine & Tool, Inc., 752 Fed.2d 1564, 224 USPQ 617 (Fed. Cir. 1985), “the Federal Circuit stressed that, to be pertinent to the issue of obviousness, the commercial success of devices falling within a patent’s claims must flow from the functions and advantages disclosed or inherent in the patent specification description of the invention.” (Emphasis added.)

See *Chisum on Patents*, § 5.02[2][f][iii], *Unclaimed Features*. In other words, advantages that are disclosed or inherent in the specification of the patent application are certainly pertinent to commercial success of the invention and non-obviousness of the invention, if those advantages flow from the claimed invention. Page 5, lines 4+, of the specification of the application indicates that a “sagging mesh can be easily stretched taught again by pulling the mesh away from the window frame on one side, stretching it tightly and re-attaching it to the window frame.” A245. In other words, sagging of a screen that occurs with conventional aluminum frame screens can be eliminated using the claimed invention, as clearly

spelled out by the specification. It is not necessary that this advantage be recited in the claims.

5. The Board has also agreed with the Examiner that the Declaration of Michael Thompson is flawed, since it “vaguely refers to a contract ‘for numerous windows for a residence project.’” A18.

Appellant’s Response

First, paragraph 3 of the Declaration by Michael Thompson states that he “worked with Mr. Randy Helzer of Point Five Windows on the... residence project.” A109. Clearly, the project that is mentioned by Mr. Randy Helzer “in excess of \$580,000” in paragraph 21 of Mr. Randy Helzer’s Declaration (A103) is the same contract that is mentioned in paragraph 2 of the Michael Thompson Declaration “in excess of \$580,000.00.” A109. Secondly, the contract for \$580,000, as pointed out above, used the Frameless Velcro Screen System (i.e., the claimed invention). Further, paragraph 4 of the Michael Thompson Declaration specifically states that “Point Five Windows used a Frameless Velcro Screen System on...the residence project” for the numerous casement windows. A109. Clearly, the numerous casement windows included the Frameless Velcro Screen System, as indicated in both the Declaration of Michael Thompson and Declaration of Mr. Randy Helzer.

B. The Declarations by Mr. Randy Helzer and Mr. Michael

Thompson properly establish “*a prima facie* case of nexus” to establish commercial success and non-obviousness pursuant to Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ 2d 1222 (Fed. Cir. 1988).

1. The Board has taken the position that both the Thompson Declaration and the Helzer Declaration “falls (sic) short of convincingly demonstrating the requisite nexus between the asserted commercial success in the window systems, within the scope of the appealed claims. Ex parte Remark, 15 USPQ 2d 1498, 1502” (Bd. Pat. App. & Int. 1990). A18-19.

Appellant’s Response

Ex parte Remark, *supra*, stands for the proposition that when an applicant in an Ex parte proceeding attempts to show commercial success, that the sale of a product or process is “due to the merits of the claimed invention.” (Emphasis added.) This is exactly what has occurred in both the Declarations of Mr. Randy Helzer and Mr. Michael Thompson. The Helzer Declaration states “[t]hat the Frameless Velcro Screen System has specific advantages over conventional frame screens that are competitive (sic) advantage for our company, as a licensee.” A101. Paragraph 10 states “[T]hat one of the competitive advantages of the Frameless Velcro Screen System is that the screen frames are eliminated from the window system.”

A102. (Emphasis added.) Paragraph 11 states “[T]hat conventional screen frames, with spans in excess of five feet, require support members to prevent the conventional screen frames from sagging or bowing into the viewing area, and such conventional screen frames are highly susceptible to damage during installation.” A102. (Emphasis added.) The Helzer Declaration therefore establishes that the claimed invention has competitive advantages and specifically identifies that the claimed invention has been successfully sold as a result of these competitive advantages, i.e., that the aluminum frame around the screen is eliminated and that support members are not required to prevent sagging.

Paragraphs 13 and 14 of the Helzer Declaration identify an advantage of the claimed invention that the Frameless Velcro Screen System can be used for “curved or other oddly shaped profiles.” A102. (Emphasis added.) Paragraphs 16 and 17 of the Helzer Declaration indicate an advantage of the claimed invention over aluminum frame screens “in salt spray,” due to the fact that conventional screen frames “may corrode when exposed to salt water spray.” A102. (Emphasis added.)

Paragraphs 18 and 19 of the Helzer Declaration state that a contract in excess of \$720,000 was entered into “in a saltwater environment in the Bahamas” and that the contract “was awarded in large part specifically because the Frameless Velcro System eliminated the conventional aluminum

screen frame that would have been susceptible to deterioration in the harsh salt air environment of the Bahamas." A102. (Emphasis added.) Hence, these advantages of the claimed invention over the prior art have been identified in the Helzer Declaration were identified as "specifically" resulting in sales. A102.

Clearly, each of these statements addresses the "merits of the claimed invention" and the advantages of the claimed invention that are either disclosed or inherent in the disclosure of the application. Ex parte Remark, supra.

Further, paragraph 15 indicates that between 1998 and 2003, when the Helzer Declaration was executed, there were over \$6,300,000 in sales in window systems that included the claimed invention. A102. These are significant sales for a small company such as Point Five Windows.

Further, the Declaration of Michael Thompson indicates that he was an architect at Lipkin Warner Design and Planning of Basalt, Colorado (paragraph 1) (A109) and that he "specifically did not want a conventional screen having a frame that is typically mounted on a casement window" for the \$580,000 project that used the claimed invention (paragraph 8). A109. (Emphasis added.) Further, Mr. Michael Thompson states that the award of the contract that included the screens of the claimed invention was due in part because the use of the claimed invention "offered aesthetic and

functional differences over any other known solution” (paragraphs 7 and 9).

A109. (Emphasis added.)

Again, the “merits” of the claimed invention are specifically spelled out in the Declaration by Mr. Michael Thompson, in accordance with Ex parte Remark, supra.

3. The establishment of a *prima facie* case of nexus does not require Appellant to prove a negative.

The Board further stated, “[F]urthermore, we agree with the examiner that the Declaration evidence fails to establish any commercial success was due to the merits of the claimed invention, rather than other activities on the part of the present assignee, e.g., advertising, sales campaigns and associations with established customers. See Cable Elec. Prod. Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-1027, 226 USPQ 881, 888 (Fed. Cir. 1985).” A19.

Cable Elec. Prod. v. Genmark, Inc., supra, does not stand for the proposition that Appellant must prove a negative, i.e., that commercial success was not due to advertising, sales campaigns, or associations with established customers. Cable Elec. Prod. v. Genmark, Inc., supra, did not so hold, and it is a misconstruction by the Board to assert that Applicant must prove that the commercial success was not due to those factors, even in an Ex parte application.

Rather, the established precedent is set forth in Ex parte Remark, supra, wherein the court cites Demaco Corp. v. F. VonLangsdorff Licensing Limited, 851 Fed.2d 1387, 7 USPQ 2d 1222 (Fed Cir. 1988).

A patentee is not required to prove as a part of its *prima facia* case that the commercial success is *not* due to factors other than the patented invention. (Emphasis in the original.)

Hence, the statement by the Board is incorrect. Appellant has established “a *prima facie* case of nexus” by showing a commercial success of the claimed invention and that the commercial success was due to the merits of the claimed invention, i.e., the advantages of the claimed invention over the prior art that are both disclosed and inherent in Appellant’s disclosure.

Demaco Corp. v. F. Von Langsdorff Licensing Ltd., *supra*.

VIII. Conclusion and Statement of Relief Sought

In conclusion, non-obviousness of the claimed invention has been established as a result of the commercial success that has been set forth in the Declarations under 37 C.F.R. § 1.132 by Mr. Randy Helzer and Mr. Michael Thompson. The Declarations establish a *prima facie* case of nexus by showing both the commercial success of the claimed invention and that the commercial success was due to the merits of the claimed invention. The

Declarations specifically set forth that the merits of the invention, i.e., the advantages of the claimed invention over the prior art, were the specific reason for the successful sales of the invention.

Appellant requests that the Court reverse the Decision of the Board.

Dated: March 5, 2008



William W. Cochran

IX. Proof of Service

United States Court of Appeals for the Federal Circuit

In Re Lundahl

2008-1151

The undersigned hereby certifies that two copies of the attached APPELLANT'S BRIEF AND ADDENDUM were sent today via first class mail to:

Office of the Solicitor
United States Patent and Trademark Office,
P.O. Box 15667
Arlington, VA 22215

Pamela Baumgaertel

Date: March 6, 2008

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X. Certificate of Compliance (Federal Rule 32)

The undersigned hereby certifies that this brief has fewer than 14,000 words (in fact, 2,887 words), as counted by the word processing software.

Dated: March 5, 2008


William W. Cochran

William W. Cochran

ADDENDUM

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The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVE B. LUNDAHL

Appeal 2006-1417
Application 09/326,405
Technology Center 3600

Decided: September 21, 2007

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
CHARLES F. WARREN, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of our Decision of October 27, 2006, wherein we sustained the Examiner's final rejection of claims 11-13 under 35 U.S.C. § 103(a).

We have thoroughly reviewed Appellant's Request but we do not subscribe to Appellant's position that we misapprehended or overlooked the points made in the Request. In our view, the arguments made by Appellant

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in the Request were fully considered in reaching our decision that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art.

Appellant poses the question "what motivation would there be for someone skilled in the art to replace a framed screen which can be installed and removed from the inside of the house with some difficulty, with an unframed screen that is designed to be easily removed from the inside when mounted on the inside of a window frame, but would be more difficult to remove and install when mounted on the exterior of a window frame?" (Request 5, first para.). However, the motivation expressed by Appellant is misplaced and misses the thrust of our reasoning in support of the legal conclusion of obviousness for the claimed subject matter. Lazarek evidences that it was known in the art to employ the well-known, conventional hook and loop fasteners for securing a window screen to a structure. Therefore, we concluded, and remain of the opinion, that one of ordinary skill in the art would have found it obvious to modify the window system of Kehne so as to utilize such conventional hook and loop fasteners to provide easy and quick mounting and dismounting of the screen. We perceive nothing nonobvious in substituting one known securing means for another when both means were known for securing a window screen to a structure, and Appellant has advanced no reason why such a modification would have been nonobvious to one of ordinary skill in the art.

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As for the Declaration evidence relied upon by Appellant, we are not convinced that the probative value we accorded the Declaration evidence was in error. We adhere to our judgment that the evidence of obviousness presented by the Examiner outweighs the evidence of nonobviousness proffered by Appellant.

In conclusion, based on the foregoing, we have granted Appellant's request to reconsider our decision, but we deny the request with respect to making any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

clj

COCHRAN FREUND & YOUNG LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Dave B. Lundahl

Examiner: Tran A, Phi Dieu N

Serial No.: 09/326,405

Group Art Unit: 3637

Filed: June 4, 1999

Docket: INOV.01US01

Title: IMPROVED WINDOW SCREEN SYSTEM

Mail Stop Appeal Brief - Patents
Assistant Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING

Honorable Board of Appeals:

In response Appeal No. 2006-1417 decided October 27, 2006, wherein the Board of Appeals affirmed the Examiner's rejection of the appealed claims, appellant requests rehearing of the Decision on Appeal.

Appellant respectfully believes that the following matters have been misapprehended or overlooked in the Board's decision:

**1. THE EXAMINER HAS FAILED TO UNDERSTAND THE TEACHINGS
OF THE KEHNE REFERENCE.**

The Board has overlooked this argument in its Decision.

In Section 10, paragraph 2 of the Supplemental Examiner's Answer, the Examiner concluded that: "... it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kehne to show the screen

being attached to the frame by hook and loop fastener because it would enable easy fitting of the screen frame around a window frame as taught by Lazarek."

On page 3 of appellant's Supplemental Reply Brief filed on November 14, 2005, appellant stated: "In Col. 1, lines 41-45 of Kehne, the window is defined as a composite casement including a fixed frame with hinged sash, wherein the frame may be completely assembled for shipment as a composite unit for installation. In Col. 2, lines 43-44, Kehne further defines the window as the fixed frame **11** in Figs. 1 and 2. In Col. 3, lines 26-40, Kehne defines the screen as fitting inside of frame **11** and seated against the outer edges of other independently applied wall construction elements that Kehne identifies as jambs **25**. Kehne further confirms that the jamb elements are independent from the window frame of Kehne in Col. 3, lines 52-56. Figures 1 and 2 clearly show that jambs **25** are building construct elements which surround Kehne's window, but are not part of the window itself; jambs **25** are illustrated with the same hatch markings as other wall sheathing **7** and wall covering **8**, instead of the hatch markings utilized to identify window components, **11** and **16**. Moreover, the components of fixed frame, **11**, are defined in Col. 2, lines 42-51, of Kehne, and do not include jambs **25**. Thus, the Examiner is incorrect in stating that '... the screen being attached to the frame by hook and loop fastener' Since Lazarek requires that the demountable screen be mounted around what would be considered to be the frame of the sliding car window, while Kehne does not mount the screen frame to the window frame, applicant believes that the two references teach away from one another; that is, Kehne mounts the screen disclosed therein to structures other than the window frame. Applicant therefore believes that the Examiner has improperly combined the Kehne and Lazarek references, and thereby failed to make a proper *prima facie* showing of obviousness."

Appellant therefore respectfully believes that the Examiner has not fully understood the teachings of the Kehne reference, and has improperly combined Lazarek with Kehne.

2. WHAT MOTIVATION WOULD THERE BE FOR SOMEONE SKILLED IN THE ART TO PLACE A SCREEN WHICH CAN READILY BE INSTALLED AND REMOVED FROM THE INSIDE OF A WINDOW FRAME IN A LOCATION IN WHICH IT CANNOT READILY BE INSTALLED OR REMOVED?

The Board has misapprehended this matter in its Decision.

On page 4 of the Decision, the Board stated that: "Appellant contends that the references are not combinable because Kehne mounts the screen on the exterior portion of the window whereas Lazarek mounts the screen to the interior portion of the window. However, it is well settled that it is not necessary for a finding of obviousness under § 103 that all the features of one reference be incorporated with the features of another reference. *In re Griver*, 354 F.2d 377, 381, 148 USPQ 197, 200 (CCPA 1966); *In re Billingsley*, 279 F.2d 689, 691, 126 USPQ 370, 372 (CCPA 1960). The relevant question is what would the collective teachings of the references have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In the present case, we are satisfied that the collective teachings of Kehne and Lazarek would have suggested the use of hook and loop fasteners for removably connecting the screen of Kehne to the fixed frame. While Appellant maintains that Kehne teaches a permanently mounted screen, we agree with the Examiner that Kehne's disclosure of supporting a screen 'in a more or less permanent manner' would have suggested a screen that is ultimately removable (see col. 1, ll. 60-62). Furthermore, we agree with the Examiner that it was notoriously well known in the art to provide removable screens in the fixed frame of a window. Applicant also maintains that Lazarek 'clearly does not suggest any method for 'mounting the screen in a permanent manner' as set forth in Appellant's claims (principal Br. 7, second paragraph). This argument is not germane to the claimed subject matter since the quoted recitation is not found in the appealed claims. Indeed, rather than calling for mounting the screen in a permanent manner, the claims recite a removable screen."

Assuming for argument that the screen of Kehne is mounted to the exterior of the frame of the window (That is, ignoring for purposes of discussion that the screen of Kehne is not mounted on the window frame thereof.), appellant believes that Kehne intended that the screen be removable for servicing, but otherwise affixed to the frame. There is no discussion of the manner in which the screen is held in place in Kehne, but screens installed on the exterior of casement window frames are not readily removed or installed from the inside. According to the American Heritage Dictionary of The English Language, 3rd Ed. (Houghton Mifflin Company, Boston, New York 1992), the principal definition for "more or less" is "about" or "approximately." Therefore, applicant respectfully believes that the screen of Kehne is intended to remain in place.

In Col. 1, lines 20-27, of Lazarek it is stated that: "Permanently attached screens to the automobile windows are undesirable in that they impair visibility and are probably not necessary in view of the fact that insect annoyance is a serious problem only when the automobile is parked, because when the vehicle is moving the rush of air past the vehicle is sufficient to prevent insects from entering a moving automobile." Lazarek continues in Col. 2, lines 20-27, that: "Accordingly, it is an object of this invention to provide a screen for a car window that may be demountably installed without the use of tools, without defacing the window frame, which is neat and inconspicuous in appearance, which may be stored in a minimum of space when not in use, and which does not interfere with the normal operation of the automobile window." Thus, Lazarek teaches the infrequent use of nonpermanent screens which can be stored in a minimum of space, but which can be readily installed and removed.

As stated hereinabove, exterior-mounted framed screens may be removed from casement windows from the inside of a house with some difficulty depending on how they are mounted. However, how can one easily attach male and female portions of Velcro tape located exterior to a window frame from the inside? Therefore, appellant believes that it clearly matters that the screen of Lazarek is

installed on the inside of a window frame if it is going to be frequently installed and removed. Further, appellant questions what motivation would there be for someone skilled in the art to replace a framed screen which can be installed and removed from the inside of the house with some difficulty, with an unframed screen that is designed to be easily removed from the inside when mounted on the inside of a window frame, but would be more difficult to remove and install when mounted on the exterior of a window frame? Clearly, the combination of Lazarek with Kehne, as suggested by the Examiner, is an attempt to reconstruct appellant's invention using impermissible hindsight.

3. HOW CAN ONE ATTACH A SCREEN TO THE WINDOW OF KEHNE WHICH IS LARGER THAN THE OPENING IN THE WINDOW FRAME?

The Board has overlooked this argument in its Decision.

On pages 2 and 3 of appellant's Supplemental Reply Brief filed on November 14, 2005, appellant stated: "Turning now to the first line of the Abstract, Col. 1, lines 44-45, Col. 3, lines 24-27, and claim 1, lines 3-4, of Lazarek clearly emphasize that the sheet of screening is to be somewhat larger than the window. Moreover, Col 3, lines 9-11, calls for canvas belting extending beyond the periphery of the screen to form a tab. This permits the screen of Lazarek to be mounted over the car window (Col. 1, lines 60-61). Kehne, in Col. 3, lines 34-40, requires that the outer edges of the jambs be spaced inwardly from the inner face of the sash frame in order to provide a seat for the frame of a window screen. From Figs. 1 and 2 it may be observed that the window screen frame is disposed inside of the perimeter of the fixed frame (the components of fixed frame, 11, are defined in Col. 2, lines 42-51) of Kehne. Kehne further requires in Figs. 1 and 2 and in Col. 3, lines 11-15, that weather stripping secured to the inner surface of the sash frame is adapted to seat in the bottoms of the grooves in the outer surface of the fixed frame. If one were to combine the teachings of Lazarek, which stress an oversized screen (one larger than the perimeter of the window panel and, as a

result, larger than the perimeter of the window frame of Lazarek), with Kehne which, by contrast, requires a screen frame and consequently a screen that is smaller than the perimeter of the fixed frame, the weather stripping secured to the inner surface of the sash frame of Kehne could not properly seat in the bottoms of the grooves provided therefor in the stationary frame. Thus, the combination of Lazarek with Kehne, as the Examiner has suggested, renders the invention of Kehne inoperative. As stated in previous papers, Kehne and Lazarek disclose the use of screens in different locations with respect to the window, and for different window designs. There is little to restrict the oversize dimensions of the screen disclosed by Lazarek, since the operation of the window is unaffected thereby. By contrast, screen dimensions are important for Kehne, since the proper operation of the sash frame would be impaired by a screen constructed in accordance with Lazarek."

Thus, appellant believes that the Board has overlooked another of the reasons one having ordinary skill would not be motivated to combine the teachings of Lazarek with those of Kehne to render obvious the present claimed invention.

Moreover, Section 2145 of the Manual of Patent Examining Procedure states that: "It is improper to combine references where the references teach away from their combination." Since Lazarek teaches away from Kehne, appellant believes that the Examiner has improperly combined these references, and thereby failed to make a proper *prima facie* showing of obviousness.

4. THE HELZER DECLARATION IS MORE SPECIFIC THAN THE EXAMINER HAS INDICATED.

The Board has overlooked this issue in its Decision.

On pages 5 and 6 of the Decision, the Board stated that: "Appellant relies on Helzer and Thompson Declarations under 37 C.F.R. § 1.132 as evidence of commercial success. However, we find that the Examiner has lodged valid

criticisms regarding the weight of the Declaration evidence. For instance, the Declaration of Helzer, the Vice President for Marketing and Sales for the present assignee, states in paragraph 15, that Five Point Windows, the exclusive licensee of a window system in accordance with the appealed claims, 'has sold over \$6,300,000 in 15 major orders of window systems that include the Frameless Velcro Screen System (emphasis added). As pointed out by the Examiner, there is no indication what proportion of the reported figure represents the sale of window systems in accordance with the appealed claims. Similarly, paragraph 18 of the Declaration reports a contract in excess of \$720,000 for unspecified windows and doors, while paragraph 21 of the Declaration refers to a contract in excess of \$580,000 for "casement type windows" that is 'due in part to the aesthetic value of the Frameless Velcro Screen System' (emphasis added). Also, while paragraph 22 of the Declaration states that the \$580,000 contract was specifically entered 'because the screen was mounted between the fixed frame and the moving sash, for a casement window,' the Examiner correctly points out that the window system of Kehne has the screen mounted between the fixed frame and the moving sash."

However, appellant respectfully points out, it was not the casement windows of Kehne that were selected; rather, the claimed Frameless Velcro Screen System of the present claimed invention was selected. Further, Paragraph 23 of the Helzer Declaration states: "That the architect specifically did not want a conventional screen frame that is typically mounted on the exterior frame of an in-swing casement window;". This is a direct affirmation of the already stated reasons that the present claimed invention was the cause of the commercial success of the Point Five Windows. Additionally, Paragraph 19 of the Helzer Declaration states that: "That the \$720,000.00 contract was awarded in large part specifically because the Frameless Velcro Screen System eliminated the conventional aluminum screen frame that would have been susceptible to deterioration in the harsh salt air environment of the Bahamas;" Appellant believes that this latter statement is dispositive on the issue that the Frameless

Velcro Screen System was specifically chosen to avoid attack on the frame as a result of proximity of the windows to the ocean, because of the "in large part" language thereof.

Additionally, In the Declaration Under 37 CFR 1.132 by Michael Thompson, it is clearly stated that the subject thereof is a casement window having a removable screen connected to the fixed frame with a hook and loop fastener system. This feature is not disclosed by the Kehne patent, and it was the recommendation of Mr. Thompson to Lipkin Warner Design and Planning, LLC which led to the purchase of a significant number of Point Five Windows having the Frameless Velcro Screen System. This recommendation was clearly based on the aesthetic and functional differences of the Point Five Windows having the Frameless Velcro Screen System over any known windows.

5. THE THOMPSON DECLARATION IS MORE SPECIFIC THAN THE EXAMINER HAS INDICATED.

The Board has overlooked this issue in its Decision.

On pages 6 and 7 of the Decision, the Board stated that: "The Declaration of Michael Thompson, an architect who supported a contract in excess of \$580,000 to the present assignee, is similarly flawed. Paragraph 2 of the Declaration vaguely refers to the contract 'for numerous windows for a residence project.' Furthermore, in paragraph 7, the Declarant states that the contract was awarded 'due in part' to the window system of the present invention. Manifestly, the Thompson Declaration, as well as the Helzer Declaration, falls short of convincingly demonstrating the requisite nexus between the asserted commercial success and window systems within the scope of the appealed claims. *Ex Parte Remark*, 15 USPQ2d 1498, 1502 (Bd. Pat. App. & Inf. 1990). Furthermore, we agree with the Examiner that the Declaration evidence fails to establish that any commercial success was due to the merits of the claimed

invention rather than other activities on the part of the present assignee, e.g., advertising, sales campaigns, and associations with established customers."

Appellant wishes to point out that Paragraphs 8 and 9 of the Thompson Declaration state: "That I specifically did not want a conventional screen having a frame that is typically mounted on a casement window for the above mentioned project;" and "That Lipkin Warner Design and Planning, LLC supported the \$580,000.00 contract award to Point Five Windows based in part on the fact that the Frameless Velcro Screen System offered aesthetic and functional differences over any other known solution, which included conventional screen frames;". Thus, appellant believes that the very words of the architect identifies the reason for the choice of the Frameless Velcro Screen System of the present claimed invention; namely, the architect did not want a conventional screen having a frame.

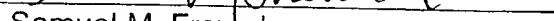
Appellant therefore requests rehearing of the Decision on Appeal.

Dated this 27th day of December 2006.

Respectfully submitted,

COCHRAN FREUND & YOUNG LLC

By:



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The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVE B. LUNDAHL

Appeal 2006-1417
Application 09/326,405
Technology Center 3600

Decided: October 27, 2006

Before KIMLN, GARRIS, and WARREN, *Administrative Patent Judges*.
KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 11-33. Claim 11 is illustrative:

11. An operable window system with a removable screen comprising:
 - a fixed frame;
 - a moving sash connected to said fixed frame and operable to substantially swing about an axis with respect to said fixed frame from an open position to a closed position; and

Appeal 2006-1417
Application 09/326,405

a removable screen without a substantially rigid peripheral frame removably connected to said fixed frame with hook and loop fasteners, said removable screen mounted between said fixed frame and said moving sash.

The Examiner relies upon the following references as evidence of obviousness:

| | | |
|---------|--------------|---------------|
| Kehne | US 2,713,896 | Jul. 26, 1955 |
| Lazarek | US 3,753,458 | Aug. 21, 1973 |
| Jones | US 5,365,707 | Nov. 22, 1994 |

Appellant's claimed invention is directed to an operable window system comprising a fixed frame, a moving sash connected to the frame and operable to swing from an open position to a closed position, and a removable screen that is mounted between the fixed frame and the moving sash. The screen is without a substantially rigid peripheral frame and is connected to the fixed frame with hook and loop fasteners.

Appealed claims 11-13, 15-18, 20-23, 25-28, and 30-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kehne in view of Lazarek. Claims 14, 19, 24, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the stated combination of references further in view of Jones.

Appellant provides separate arguments for claims 20 and 25, as a group. Accordingly, claims 11-13, 15-18, 21-23, 26-28, and 30-33 stand or fall together as a group, as do separately rejected claims 14, 19, 24, and 29.

We have thoroughly reviewed each of Appellant's arguments for patentability, as well as the declaration evidence relied upon in support thereof. However, we are in complete agreement with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the Examiner's rejections for the reasons set forth in the Answer, which we incorporate herein, and we add the following primarily for emphasis.

Appellant does not contest the Examiner's factual determination that Kehne, like Appellant, discloses an operable window system comprising a fixed frame, a moving sash operable to substantially swing about an axis with respect to the fixed frame from an open position to a closed position, and a screen that is mounted between the fixed frame and the moving sash. As recognized by the Examiner, Kehne does not disclose that the screen is connected to the fixed frame with hook and loop fasteners. However, as explained by the Examiner, Lazarek discloses a removable window screen that is attached to the window's fixed frame with hook and loop fasteners which provide easy and quick mounting and dismounting of the screen. Accordingly, based on the collective teachings of Kehne and Lazarek, we concur with the Examiner that it would have been obvious for one of ordinary skill in the art to employ the hook and loop fasteners of Lazarek in the window system of Kehne to provide the described advantage of enabling the screen to be readily mounted and dismounted. We also find that one of

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ordinary skill in the art would have appreciated any savings in cost associated with replacing an aluminum frame with a periphery of hook and loop fasteners.

Appellant contends that the references are not combinable because Kehne mounts the screen on the exterior portion of the window whereas Lazarek mounts the screen to the interior portion of the window. However, it is well settled that it is not necessary for a finding of obviousness under § 103 that all the features of one reference be incorporated with the features of another reference. *In re Griver*, 354 F.2d 377, 381, 148 USPQ 197, 200 (CCPA 1966); *In re Billingsley*, 279 F.2d 689, 691, 126 USPQ 370, 372 (CCPA 1960). The relevant question is what would the collective teachings of the references have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In the present case, we are satisfied that the collective teachings of Kehne and Lazarek would have suggested the use of hook and loop fasteners for removably connecting the screen of Kehne to the fixed frame. While Appellant maintains that Kehne teaches a permanently mounted screen, we agree with the Examiner that Kehne's disclosure of supporting a screen "in a more or less permanent manner" would have suggested a screen that is ultimately removable (see col. 1, ll. 60-62). Furthermore, we agree with the Examiner that it was notoriously well known in the art to provide removable screens in the fixed frame of a window.

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Appellant also maintains that Lazarek “clearly does not suggest any method for ‘mounting the screen in a permanent manner’ as set forth in Appellant’s claims” (principal Br. 7, second paragraph). This argument is not germane to the claimed subject matter since the quoted recitation is not found in the appealed claims. Indeed, rather than calling for mounting the screen in a permanent manner, the claims recite a removable screen.

Appellant also makes the argument that:

Claims 20 and 25 recite an additional limitation in which the removable screen is mounted between the fixed frame and the moving sash such that the moving sash is in contact with the removable screen when the moving sash is in the closed position such that the hook and loop fastener is engaged. (principal Br. 8, second paragraph). However, as accurately noted by the Examiner, Figure 3 of Kehne “shows the sash touching the screen when the sash is in the closed position” (Supp. Answer 8, last paragraph).

As for the separately argued claims directed to the window system being non-rectangular, we concur with the Examiner that Jones evidences the obviousness of making windows of various shapes.

Appellant relies upon the Helzer and Thompson Declarations under 37 C.F.R. § 1.132 as evidence of commercial success. However, we find that the Examiner has lodged valid criticisms regarding the weight of the Declaration evidence. For instance, the Declaration of Helzer, the Vice President for Marketing and Sales for the present assignee, states in paragraph 15 that Point Five Windows, the exclusive licensee of a window system in accordance with the appealed claims, “has sold over \$6,300,000 in

15 major orders of window systems that include the Frameless Velcro Screen System" (emphasis added). As pointed out by the Examiner, there is no indication what proportion of the reported figure represents the sale of window systems in accordance with the appealed claims. Similarly, paragraph 18 of the Declaration reports a contract in excess of \$720,000 for unspecified windows and doors, while paragraph 21 of the Declaration refers to a contract in excess of \$580,000 for "casement type windows" that is "due in part to the aesthetic value of the Frameless Velcro Screen System" (emphasis added). Also, while paragraph 22 of the Declaration states that the \$580,000 contract was specifically entered "because the screen was mounted between the fixed frame and moving sash for a casement window," the Examiner correctly points out that the window system of Kehne has the screen mounted between the fixed frame and the moving sash. In addition, although paragraph 11 of the Declaration states that "conventional screen frames with spans in excess of five feet require support members," the appealed claims do not recite any particular size for the screen.

The Declaration of Michael Thompson, an architect who supported a contract in excess of \$580,000 to the present assignee, is similarly flawed. Paragraph 2 of the Declaration vaguely refers to the contract "for numerous windows for a residence project." Furthermore, in paragraph 7, the Declarant states that the contract was awarded "due in part" to the window system of the present invention. Manifestly, the Thompson Declaration, as well as the Helzer Declaration, falls short of convincingly demonstrating the

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requisite nexus between the asserted commercial success and window systems within the scope of the appealed claims. *Ex parte Remark*, 15 USPQ2d 1498, 1502 (Bd. Pat. App. & Int. 1990).

Furthermore, we agree with the Examiner that the Declaration evidence fails to establish that any commercial success was due to the merits of the claimed invention rather than other activities on the part of the present assignee, e.g., advertising, sales campaigns, and associations with established customers. *See Cable Elec. Prod. Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026-27, 226 USPQ 881, 888 (Fed. Cir. 1985).

Accordingly, it is our judgment that Appellant's evidence of nonobviousness, including the Declaration evidence of commercial success, does not outweigh the evidence of obviousness presented by the Examiner. *In re Rynkiewicz*, 390 F.2d 742, 746, 156 USPQ 462, 465 (CCPA 1968).

In conclusion, based on the foregoing and the reasons well stated by the Examiner, the Examiner's decision rejecting the appealed claims is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2004).

AFFIRMED

clj

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